

OCT. 12. 2004 6:16PM

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NO. 0050 P. 12



Atty. Dkt. No. SALK 1720-6
(088802-3109)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Mathews et al.

Title: CLONING AND RECOMBINANT
PRODUCTION OF
RECEPTOR(S) OF THE
ACTIVIN/TGF-BETA
SUPERFAMILY

Appl. No.: 09/742,684

Filing Date: 12/19/2000

Examiner: R. Li

Art Unit: 1646

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| <p>CERTIFICATE OF FACSIMILE TRANSMISSION</p> <p>I hereby certify that this correspondence is being facsimile deposited with the United States Patent Office in Alexandria, VA 22313-1450, on the date below.</p> <p>Stephen E. Reiter (Printed Name)</p> <p><i>[Signature]</i> (Signature)</p> <p>10/12/04 (Date of Deposit)</p> |
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APPLICATION FOR PATENT TERM ADJUSTMENT

UNDER 37 C.F.R. §1.705

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants respectfully request reconsideration of the patent term adjustment (PTA) of 0 days as indicated on the Determination of Patent Term Adjustment under 35 U.S.C. 154 (b) mailed on July 12, 2004. The total PTA should be 613 days as determined below.

Upon review of the Patent Term Adjustment History using the Patent Application Information Retrieval (PAIR) database, Applicants note an inaccuracy of 586 days. The total Applicant delay is incorrectly listed as:

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(b) 108 days (from PTO action of alleged "Informal or Non-Responsive Amendment after Examiner Action" on 09-26-03 until the improper PTO assertion of "Mail Notice of Informal or Non-responsive Amendment" was withdrawn on 01-12-04).

(c) In addition, Applicants should be credited 370 days for USPTO delays since the Projected Patent Grant Date is January 18, 2005, an additional total of 370 days beyond January 14, 2004 (three years after the filing of the above-identified application).

EXPLANATION

With respect to point (a) above, 162 days of delay have been erroneously charged to the Applicant. In fact, only 27 days are attributable to Applicant delay (accumulated from the initial due date of 4-06-02 (based on a USPTO mail date of 03-06-02) to the date the Response was faxed to the USPTO on 05-03-02). The remaining 135 days of delay are attributable to USPTO delay, accumulated from the day of receipt of the Response at the USPTO on 05-03-02, to the date of mailing of the Notice of Rescinded Abandonment by the USPTO on 01-02-03. The 135 days were due to internal delays at the USPTO and should not be charged to Applicant,

With respect to point (b) above, 108 days delay was improperly attributed to the Applicant from 09-26-03, when an erroneous "Non-Responsive Amendment after Examiner Action" was mailed by the USPTO, until 01-12-04 when Applicant's response was finally acknowledged by the USPTO to be responsive after all. Thus, the entire 108 days delay were due to improper USPTO action, and therefore, should not be charged to Applicant.

Finally, with respect to point (c) above, the present application was filed on December 19, 2000. Thus, the three year period to end prosecution expires no later than January 14, 2004. In view of the projected patent grant date of January 18, 2005, there are an additional 370 days that should be charged to USPTO delays.

Therefore, the net Patent Term Adjustment should be 613 days ($162+108+370=640$ USPTO days - 27 Applicant days). Accordingly, it is respectfully requested that the total patent

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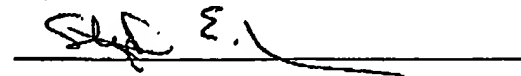
term adjustment of 613 days be issued in favor of the Applicants. This patent is not subject to a terminal disclaimer.

It is further requested that the fee of \$200.00 be waived in light of the above circumstances. However, if the Patent Office determines that the fee is required, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 50-0872.

In the event any matters remain to be resolved in view of this communication, the Examiner is encouraged to call the undersigned so that a prompt disposition of this application for patent term adjustment can be achieved.

Respectfully submitted,

Date: October 12, 2004



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